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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,662	03/04/2005	Peter Rieth	PC10495US	3137
23122	7590	12/01/2006	EXAMINER	
RATNERPRESTIA P O BOX 980 VALLEY FORGE, PA 19482-0980			WILLIAMS, THOMAS J	
			ART UNIT	PAPER NUMBER
			3683	

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/526,662	RIETH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Thomas J. Williams	3683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 March 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 7-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 7-12 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 04 March 2005 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  - 1. Certified copies of the priority documents have been received.
  - 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____.                                     |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/04/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____.                         |

### **DETAILED ACTION**

1. Acknowledgment is made in the receipt of the oath, the information disclosure statement, the priority papers and the preliminary amendment filed March 4, 2005.

#### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: reference character 6, as shown in figures 1 and 2, is not described in the description. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. It is unclear to the examiner what types of “tools” fall within the metes and bounds of the recitation “special tools”. Each tool is designed for a specific function; as such every tool is considered a special tool.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 7-9 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,810,316 Yokoyama et al.

Re-claim 7, Yokoyama et al. disclose an electromechanically operable disc brake for motor vehicles, comprising a brake caliper 11, an actuator 7, two friction linings 21 on opposing sides of a brake disc 75, at least one of the friction linings move into contact with the disc by way of the actuator, the actuator has an electric motor 15 driven by means of an electronic control and regulation unit 6, wherein the control and regulation unit 6 is arranged at the actuator, see figure 1.

Re-claims 8 and 9, the control and regulation unit is thermally uncoupled from the actuator, the control and regulation unit 6 is a separate entity that is secured to the housing element 14 of the actuator. The outer portion of the housing unit functions as spacers, which thermally uncoupling the control unit 6 from the actuator/motor 15.

Re-claim 12, the actuator and control unit are subassemblies, see column 4 lines 13-21, and as such can be handled independently and tested independently.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokoyama et al. in view of WO 02/47953 A1 to Staltmeir et al.

US 2003/0121734 A1 is the English language equivalent to the WO document.

Re-claim 10, Yokoyama et al. fail to teach the electric connection between the control unit and the actuator as a plug coupling. Staltmeir et al. teach an electromechanical brake, wherein the electric connection between the control unit housing 6 and the actuator housing 2 is a plug coupling 26. This provides a quick and easy means by which one can accurately connect the control structure of the brake with the actuating structure of the brake, as well as eliminate

the transmission of vibration transmitting bridges between the two structure, see paragraph 0011.

It would have been obvious to one of ordinary skill in the art to have provided the control unit and actuator of Yokoyama et al. with a plug coupling as taught by Staltmeir et al., thus providing a quick and positive means of attaching the control unit to the actuator.

Re-claim 11, Yokoyama et al. (in column 4 lines 13-21) and Staltmeir et al. (paragraph 0015) each teach the control unit being detatchably fastened to the actuator housing. However, neither teach the specific means used to attach the control unit to the actuator, and as such fail to designate the type of tool used for this process. The use of threaded bolts for detatchably attaching two separate components is common in the art, as such it would have been obvious to one of ordinary skill in the art to have simply bolted the control unit housing of Yokoyama et al. to the actuator housing, thus utilizing a common and simple means for attaching two components together in a detachable manner. As such the special tool would have been the tool size needed for the size of bolt used.

### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Doricht, Balz and Nilsson each teach an electromechanical brake with a control unit located at the actuator.

12. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Thomas Williams whose telephone number is 571-272-7128. The examiner can normally be reached on Tuesday from 1:00 PM to 7:00 PM and Wednesday-Friday from 6:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James McClellan, can be reached at 571-272-6786. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-6584.

TJW

**THOMAS J. WILLIAMS  
PRIMARY EXAMINER**

November 29, 2006

Thomas Williams  
AU 3683  
11-29-06